



Attorney's Docket No. 16-604

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the
Application of: HOEKSTRA, TODD

Examiner: JOHN R.
PARADISO

Application No.: 09/932,745

Art Unit: 3721

Filing Date: AUGUST 17, 2001

Title: CONTINUOUS WEB OF
BREATHING POUCHES
AND AUTOMATED
METHOD OF PACKAGING
MEDICAL DEVICES
UTILIZING SUCH
POUCHES

AMENDMENT TRANSMITTAL

MS NO FEE AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22213-1450

Transmitted herewith is an Amendment for this application.

The fee for claims has been calculated as shown below:

CLAIMS	FOR	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	CALCULATIONS
	TOTAL CLAIMS (37 C.F.R. § 1.16(c))	35	49	0	x \$18.00 =	\$ 00.00
	INDEPENDENT CLAIMS (37 C.F.R. § 1.16(b))	6	8	0	x \$86.00 =	\$ 00.00
	MULTIPLE DEPENDENT CLAIMS (if applicable) (37 C.F.R. § 1.16(d))				+ \$280.00	\$ 0.00
	Total of Above Calculations =					\$ 0.00
	Reduction by 50% for filing by small entity (Note 37 C.F.R. §§ 1.9, 1.27, 1.28).					\$ 0.00
	TOTAL =					\$ 0.00

☒ Small entity status is claimed under 37 C.F.R. §§ 1.9, 1.27:

☐ A check is enclosed to cover the \$____ fee for the presentation of additional claims.

☐ A check is enclosed to cover the \$____ fee for the Terminal Disclaimer under 37 C.F. R. 1.321(c)

☐ Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that Applicant has inadvertently overlooked the need for a petition for an extension of time.

☐ Applicant hereby petitions for a:

☐ one month (37 C.F.R. § 1.17(a): \$110.00/\$55.00)
☐ two month (37 C.F.R. § 1.17(b): \$420.00/\$210.00)
☐ three month (37 C.F.R. § 1.17(c): \$950.00/\$475.00)
☐ four month (37 C.F.R. § 1.17(d): \$1,480.00/\$740.00)
☐ five month (37 C.F.R. § 1.17(d): \$2,010.00/\$1,005.00)

extension of time pursuant to 37 C.F.R. § 1.136(a). If an additional extension of time is required, please consider this a petition therefor.

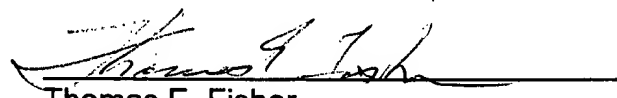
☐ A check is enclosed to cover the \$.00 extension of time fee under 37 C.F.R. § 1.17.

_____ Charge Deposit Account No. 23-0630 in the amount of \$ 0.00 for presentation of additional claims.

X The Commissioner is hereby authorized to credit any overpayment or to charge any fees under 37 C.F.R. §§ 1.16, 1.17 in connection with this communication to our Deposit Account No. 23-0630.

Respectfully submitted,

Date: October 19, 2004


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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Todd Hoekstra

Serial No.: 09/932,745

Group Art Unit: 3721

Filed: August 17, 2001

Examiner: John Roger Paradiso

For: CONTINUOUS WEB OF BREATHER POUCHES AND AUTOMATED
METHOD OF PACKAGING MEDICAL DEVICES UTILIZING SUCH
POUCHES

Docket: 16-604

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MS FEE AMENDMENT

Assistant Commissioner for Patents
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Alexandria, VA 22313-1450

**RESPONSE TO THE OFFICE ACTION
OF MAY 14, 2004**

Dear Sir:

First, please note that the docket number the PTO is using as the attorney docket number is that of our predecessor. Our docket number is 16-604. What follows is an edited version of a discussion paper previously submitted. The edits reflect a discussion between the Examiner and Applicant's Attorney on September 14, 2004. Applicant's Attorney referred to chains of pre-opened bags. The Examiner's response made clear he had not grasped the fact Applicant's disclosed and preferred embodiment is made up of interconnected preopened bags. The "chains

of preopened bags” terminology this Attorney used in the interview is based on years of representing Automated Packaging Systems, Inc. It appeared to be new to the Examiner in that he did not seem to have understood the claims being examined are directed to chains of preopened bags. The claims of this application are directed to novel chains of pre-opened bags. The art upon which the Examiner relies does not teach or suggest preopened bags.

Please refer to the definition of “line of separation” on page 6 lines 18 et. seq. of the specification. Thus, the references neither teach or suggest the limitation called for in claim clause a)iii of claim 1.

We respectfully suggest that the Examiner has misunderstood the applicant’s disclosure and developed a hindsight obviousness rejection. The rejection is based on two patents which together do not have applicant’s claimed structure or features nor are the structures and features rendered obvious.

The Examiner seems to have totally ignored that aspect of the applicant’s declaration, which states some of those licensees “indicated they did not have the capabilities of producing such prototypes.” There we have it! Those people who have been making sterilizable packages using the Tyvek product didn’t have the capabilities of making applicant’s product is strong evidence of unobviousness. But, the Examiner finds it obvious to combine two references which won’t produce it even in hindsight. Neither of these references has a pouch construction corresponding to that disclosed and claimed by applicant and neither of them has or suggests a longitudinal chain of pre-opened, sterilizable packages.

The Examiner should not so quickly dismiss the fact that 12 licensees were not willing to invest any time or money in attempting to produce a prototype of the product. The product potentially has a very significant and substantial market. We submit this refusal to make prototypes when coupled with the facts that a) no one previously had provided tear strips through perforations in a Tyvek product and b) this applicant had to go through significant testing and experimentation to produce a terrible Tyvek product, strongly suggests that at least some of those licensees thought it couldn't be done. This is strong, indeed irrefutable, evidence of non-obviousness.

Further, contrary to the Examiner's contentions, Otsu does not teach tearable perforations. What he does teach in the referenced portion of column 3 is "perforations to facilitate cutting." Applicant teaches tearing as distinguished from cutting. With cutting, one needs a tool. With tearing, one needs only a little manually applied force. Further, claims 24 and 42 call for pouches which are connected by lines of weakness in the first layer [the microbial inner layer]. Claim 38 clause d calls for lines of separation, while claim 50 clause d states each bag has a top opening.

We also note in passing that Weiss is not a two-layer system but rather a three-layer. Further, we do not see Weiss as having pre-opened bags. The Examiner finds it obvious to have pre-opened bags but cites nothing which suggests such. Please tell us what suggests a chain of pre-opened bags.

We respectfully demur to the Examiner's contention that phrases such as may be sterilized and subsequently accessed without fear of contamination by residues being a mere

recitation of intended use. Perhaps they are recitations of intended use but they are recitations of structural capabilities, which permit that intended use. For that reason, if no other, the recitations should be given patentable weight in that they distinguish from the art which according to the Examiner renders claims obvious.

We recognize that patentable inventions viewed in hindsight often appear quite obvious when they are not. We submit that as a very least – Examiner should give some credence to the recitations in claims 13, 23, 28 and 52 of specific dimensions for perforations which have been found to work in the material applicant is using when perforations of other dimensional characteristics were found unsatisfactory. The Examiner has not even made a pretext of a basis for a finding of obviousness as to how one perforates the specifically disclosed material manufactured by DuPont in order to effectively be torn when used on one of the bagging machines of Automated Packaging or the equivalent.

Only applicant's teaching has resulted in the Examiner putting together two otherwise dissimilar references to produce a hindsight rejection of obviousness and that rejection persists in the face of the evidence of unobviousness.

Finally, we have assumed that claim 18 should have been included in the group of section II of the Office Action or alternatively with claims 6 and 17 as rejected in section III. We would appreciate a supplemental action to clarify the basis of rejection of claim 18.